

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH D. REVNELL

Appeal No. 2005-0057
Application No. 09/505,119



ON BRIEF

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent
Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Joseph D. Revnell appeals from the final rejection of claims 2 through 18, 25, 30 through 67 and 69. Claims 26 through 29 and 68, the only other claims pending in the application, stand allowed.

THE INVENTION

The invention relates to a device and method for measuring and laying out an area. Representative claims 9 and 25 read as follows:

9. A measuring and layout device comprising:

a stationary member having a flat surface adapted to be marked on; and
an angle and distance device fixedly and rotatably attached to the stationary member, the angle and distance device including a longitudinally and laterally rigid extendable tape that can be extended from a central point and an edge that facilitates reliably marking on the stationary member to form an accurate template as the angle and distance device is rotated and the tape is extended and retracted to critical features of an area;

wherein the template is formed by markings written directly onto the stationary member.

25. A method of measuring and laying out an area comprising:

providing a stationary member having a flat surface adapted to be marked on;

fixedly and rotatably attaching an angle and distance device to the stationary member, the angle and distance device including a longitudinally and laterally rigid extendable tape that can be extended from a central point and an edge that facilitates reliably marking on the stationary member; and

forming an accurate template by reliably marking on the stationary member as the angle and distance device is rotated and the tape is extended and retracted to critical features of the area.

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THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Moxey	2,349,670	May 23, 1944
Barker	3,269,015	Aug. 30, 1966
Martinez	4,344,231	Aug. 17, 1982
Rauch et al. (Rauch)	4,835,870	Jun. 06, 1989
Trevino	5,768,797	Jun. 23, 1998
Arcand	6,115,931	Sep. 12, 2000
Mercier, French Patent Document ¹	2 614 982	Nov. 10, 1988

THE REJECTIONS

Claims 25, 54 through 56, 58, 59, 61, 62 and 69 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Martinez.

Claims 17, 40, 42 through 48, 53, 60 and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinez.

Claims 51 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinez in view of Mercier.

¹ An English language translation of this reference, prepared on behalf of the United States Patent and Trademark Office, is appended hereto.

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Claims 2 through 4, 7, 9, 11, 12, 14, 25, 54 through 56, 58, 60, 62, 63 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey.

Claims 5 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey and Rauch.

Claims 6, 13, 30, 32, 34, 36 through 38 and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey and Trevino.

Claims 8, 10, 59 and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey and Martinez.

Claims 15 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey and Mercier.

Claims 16 and 67 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey and Arcand.

Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey, Trevino and Rauch.

Claims 33 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey, Trevino and Martinez.

Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Moxey, Trevino and Arcand.

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Claims 17, 40, 43, 45, 47, 48 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker.

Claims 18 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Arcand.

Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Rauch.

Claims 44 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Martinez.

Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Trevino.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barker in view of Mercier.

Attention is directed to the main brief (filed May 8, 2004) and first and second reply briefs (filed October 20, 2003 and March 26, 2004) and to the examiner's answer (mailed February 18, 2004) for the respective positions of the appellant and the examiner regarding the merits of these rejections.²

² In the final rejection (mailed January 22, 2003), claims 17, 18 and 40 through 53 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, claim 64 also stood rejected under 35 U.S.C. § 102(b) as being anticipated by Martinez, and claim 49 also stood rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinez. The examiner (see page 3 in the answer) has since withdrawn these rejections in light of the arguments advanced in the appellant's briefs.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 25, 54 through 56, 58, 59, 61, 62 and 69 as being anticipated by Martinez

Martinez seeks "to ease the often tedious job of mapping land surface contours and boundaries" (column 1, lines 12 and 13) by providing "a simple, inexpensive apparatus by which the general horizontal outline or boundary of a land surface area, such as a green on a golf course, can be mapped onto a sheet of paper" (column 1, lines 28 through 31). To this end, the disclosed apparatus 2 comprises a circular board 12, a plurality of pointed legs 18 extending downwardly from the board to securely engage the surface of a green, a pivot peg 14 extending upwardly from the board, a sheet of graph paper 44 attached to the top of the board, and a dual segment measuring element 16 disposed on the upper surface of the board. The dual segment measuring element includes an inner proportional measuring segment 22 having a pivot hole 26 slightly larger than, and fitting over, the pivot peg and an outer full scale measuring segment 34 composed of a tape 38 and tape reel 36. In use, [t]he user places board 12 on green 4 in a suitable location An assistant then pays out tape 34 from tape reel 36 until the edge 46 of green 4 is reached. Pulling measuring element 16 somewhat taut, to assure an accurate reading in distance and rotary position, the assistant reads off the distance from measurement scale 42 on tape 34 where the tape crosses the edge 46 of the green. This point is indicated in

FIG. 1 by an "x" 48. This distance is transferred to sheet 44 at the corresponding point on proportional scale 30 by the user. Measuring element 16 is then indexed about pivot peg 14 an appropriate distance and a new measurement is called out by the assistant to the user. This process is repeated as often as necessary to achieve the desired degree of resolution [column 2, line , through column 3, line 12].

The appellant's argument that the subject matter recited in independent claim 25 is not anticipated by Martinez because this reference does not meet the recitation in the claim of the step of "fixedly and rotatably attaching an angle and distance device to the stationary member" is persuasive. The Martinez angle and distance device (dual segment measuring element 16) is rotatably attached to its associated stationary member (board 12) by virtue of pivot hole 26 fitting over pivot peg 14. As the pivot hole 26 merely slips over the pivot peg 14, the angle and distance device is not "fixedly" attached to the stationary member under any reasonable interpretation of this term.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 25, and dependent claims 54 through 56, 58, 59, 61 and 62, as being anticipated by Martinez.

We shall sustain, however, the standing 35 U.S.C. § 102(b) rejection of independent claim 69 as being anticipated by Martinez.

The appellant's contention that this rejection is unsound because Martinez does not meet the recitation in claim 69 of the step of "recording angle information for each distance recording signifying an angle of the tape relative to the stationary member" is not persuasive. As indicated above, Martinez expressly teaches the accurate reading of distance and rotary position, and the corresponding marking of such on sheet 44 relative to the center of the pivot hole 26. Claim 69 does not, as urged by the appellant, require two recording acts: one for distance and one for angle.

II. The 35 U.S.C. § 103(a) rejection of claims 17, 40, 42 through 48, 53, 60 and 63 as being unpatentable over Martinez

In addition to not teaching a method comprising the step of "fixedly and rotatably attaching an angle and distance device to the stationary member" as recited in independent parent claim 25, Martinez would not have suggested same to one of ordinary skill in the art. Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 60 and 63 as being unpatentable over Martinez.

Martinez also would not have suggested a method meeting the limitation in independent claim 17 requiring the measuring and laying out of a template of a "room." Although Martinez does indicate that the area mapping method disclosed therein can be

used with respect to surfaces other than a golf course green, the clear intent of the reference, given the specific problem being addressed and the physical nature of the disclosed device with its pointed ground-engaging legs, is that such other surfaces are land surfaces.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 17, and dependent claims 40, 42 through 48 and 53, as being unpatentable over Martinez.

III. The 35 U.S.C. § 103(a) rejection of claims 51 and 66 as being unpatentable over Martinez in view of Mercier

As the examiner's application of Mercier does not overcome the above noted shortcomings of Martinez relative to parent claims 17 and 25, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 51 and 66 as being unpatentable over Martinez in view of Mercier.

IV. The 35 U.S.C. § 103(a) rejection of claims 2 through 4, 7, 9, 11, 12, 14, 25, 54 through 56, 58, 60, 62, 63 and 65 as being unpatentable over Barker in view of Moxey

The appellant contends that this rejection is unsound because the combined teachings of Barker and Moxey would not have suggested a device and method meeting the limitations in independent claims 9, 12 and 25 requiring an angle and distance device which is fixedly and rotatably attached to a stationary member.

Barker discloses a layout tool for scribing angles, and measuring and laying out squares and rectangles. The tool comprises a lower arm 10, an upper arm 11, a pivot member 12 joining the arms at respective ends thereof, a wing nut 15 for locking the arms in a desired angular position, retractable rules and their casings 20, 21, 28 and 29 on the free ends of the arms, and scribe pins and blocks 23, 25, 31 and 33 on the distal ends of the rules. The tool is capable of scribing lines 39 and arcs 40 in the manner shown in Figure 3.

Barker's lower arm 10 effectively constitutes a stationary member and Barker's upper arm 11 and rule/casing 28 and 29 effectively constitute an angle and distance device. This angle and distance device is fixedly and rotatably attached to the stationary member by means of the pivot member 12 and the wing nut 15.

Thus, notwithstanding the appellant's argument, Barker alone meets the argued limitations in independent claims 9, 12 and 25. We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of claims 9, 12 and 25, and dependent claims 2 through 4, 7, 11, 14, 54 through 56, 58, 60, 62, 63 and 65, as being unpatentable over Barker in view of Moxey.

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V. The 35 U.S.C. § 103(a) rejection of claims 5 and 57 as being unpatentable over Barker in view of Moxey and Rauch

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 5 as being unpatentable over Barker in view of Moxey and Rauch since the appellant has not challenged such with any reasonable specificity, thereby allowing claim 5 to stand or fall with parent claim 12 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

We shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 57 as being unpatentable over Barker in view of Moxey and Rauch.

Claim 57 depends ultimately from independent claim 25 and requires the step of making a mark along the straight edge of a front leg of a carrier of the angle and distance device. The examiner proposes to remedy Barker's admitted failings in this regard with Rauch's disclosure of a device for measuring distances and directions on a road map for input into a navigator. Although the Rauch device does include a rotatable tape mounting bracket 11 having a front end or leg area 11c, there is nothing in the combined teachings of Barker, Moxey and Rauch which would have suggested adding such a front end to Barker's angle and distance device carrier and then using

same to make a mark along a straight edge thereof as recited in claim 57.

VI. The 35 U.S.C. § 103(a) rejection of claims 6, 13, 30, 32, 34, 36 through 38 and 64 as being unpatentable over Barker in view of Moxey and Trevino

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 6, 13 and 64 as being unpatentable over Barker in view of Moxey and Trevino since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claims 12 and 25 (see Nielson, supra).

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 30, and dependent claims 32, 34 and 36 through 38, as being unpatentable over Barker in view of Moxey and Trevino. The appellant contends that this rejection is unsound because the applied references would not have suggested a device meeting the limitations in independent claim 30 requiring an extendable tape carrier which is fixedly and rotatably attached to a stationary member. As discussed above, however, Barker discloses an upper arm 11 and rule/casing 28 and 29 which effectively constitute an extendable tape carrier fixedly and rotatably attached to stationary member 10 by means of the pivot member 12 and the wing nut 15. Thus, Barker itself meets the

claim limitation in question.

VII. The 35 U.S.C. § 103(a) rejection of claims 8, 10, 59 and 61 as being unpatentable over Barker in view of Moxey and Martinez

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 10 and 61 as being unpatentable over Barker in view of Moxey and Martinez since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claims 12 and 25 (see Nielson, supra).

We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejection of dependent claims 8 and 59 as being unpatentable over Barker in view of Moxey and Martinez.

Claims 8 and 59 define the stationary member as a board having non-slip feet. The examiner cites Martinez to overcome Barker's lack of response to these limitations. There is nothing in the Martinez disclosure of an apparatus for mapping a golf course green, however, which would have suggested the requisite changes to the Barker scribing apparatus and method.

VIII. The 35 U.S.C. § 103(a) rejection of claims 15 and 66 as being unpatentable over Barker in view of Moxey and Mercier

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 15 and 66 as being unpatentable over Barker

in view of Moxey and Mercier since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claims 12 and 25 (see Nielson, supra).

IX. The 35 U.S.C. § 103(a) rejection of claims 16 and 67 as being unpatentable over Barker in view of Moxey and Arcand

Claims 16 and 67 recite a measuring/layout device and method, respectively, encompassing a tape having a pivotal pointer at a distal end. Barker and Moxey do not teach, and would not have suggested, such subject matter.

Arcand discloses a tape measure device having a pin 100 pivotally mounted on the distal end of the tape for piercing an object in order to attach the tape thereto. Contrary to the position taken by the examiner, such disclosure would not have suggested adding such a pin to the distal ends of either of Barker's tapes as such a modification would be inconsistent and interfere with the fundamental scribing purpose of the Barker device.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 16 and 67 as being unpatentable over Barker in view of Moxey and Arcand.

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X. The 35 U.S.C. § 103(a) rejection of claim 31 as being unpatentable over Barker in view of Moxey, Trevino and Rauch

We shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 31 as being unpatentable over Barker in view of Moxey, Trevino and Rauch since the appellant has not challenged such with any reasonable specificity, thereby allowing this claim to stand or fall with parent claim 30 (see Nielson, supra).

XI. The 35 U.S.C. § 103(a) rejection of claims 33 and 35 as being unpatentable over Barker in view of Moxey, Trevino and Martinez

We shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 35 as being unpatentable over Barker in view of Moxey, Trevino and Martinez since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 30 (see Nielson, supra).

We shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 33 as being unpatentable over Barker in view of Moxey, Trevino and Martinez. Dependent claim 33 requires the stationary member to be a board having non-slip feet. For the reasons expressed above with respect to claims 8 and 59, the examiner's application of Martinez to supply Barker with this feature is not tenable.

XII. The 35 U.S.C. § 103(a) rejection of claim 39 as being unpatentable over Barker in view of Moxey, Trevino and Arcand

Dependent claim 39 requires the tape to have a pivotal

pointer at its distal end. For the reasons discussed above in connection with claims 16 and 67, Arcand would not have suggested adding such a feature to the distal ends of either of Barker's tapes.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 39 as being unpatentable over Barker in view of Moxey, Trevino and Arcand.

XIII. The 35 U.S.C. § 103(a) rejection of claims 17, 40, 43, 45, 47, 48 and 50 as being unpatentable over Barker

As indicated above, Barker discloses a layout tool for scribing angles, and measuring and laying out squares and rectangles. This reference does not teach using the tool to measure and lay out a template of a room, let alone doing so by extending a tape measure to a critical feature of an area in a room to be measured, and recording direction and distance information on a stationary member from the tape measure relating to the critical feature, all as recited in independent claim 17. In short, the examiner has not provided the factual basis necessary to conclude that these differences are such that the subject matter recited in claim 17 would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Accordingly, we shall not sustain the standing 35 U.S.C.

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§ 103(a) rejection of independent claim 17, and dependent claims 40, 43, 45, 47, 48 and 50, as being unpatentable over Barker.

XIV. The 35 U.S.C. § 103(a) rejection of claims 18 and 52 as being unpatentable over Barker in view of Arcand

As the examiner's application of Arcand does not cure the above noted shortcomings of Barker relative to parent claim 17, we shall not sustain the 35 U.S.C. § 103(a) rejection of dependent claims 18 and 52 as being unpatentable over Barker in view of Arcand.

XV. The 35 U.S.C. § 103(a) rejection of claim 41 as being unpatentable over Barker in view of Rauch

As the examiner's application of Rauch does not cure the above noted shortcomings of Barker relative to parent claim 17, we shall not sustain the 35 U.S.C. § 103(a) rejection of dependent claim 41 as being unpatentable over Barker in view of Rauch.

XVI. The 35 U.S.C. § 103(a) rejection of claims 44 and 46 as being unpatentable over Barker in view of Martinez

As the examiner's application of Martinez does not cure the above noted shortcomings of Barker relative to parent claim 17, we shall not sustain the 35 U.S.C. § 103(a) rejection of dependent claims 44 and 46 as being unpatentable over Barker in view of Martinez.

XVII. The 35 U.S.C. § 103(a) rejection of claim 49 as being unpatentable over Barker in view of Trevino

As the examiner's application of Trevino does not cure the above noted shortcomings of Barker relative to parent claim 17, we shall not sustain the 35 U.S.C. § 103(a) rejection of dependent claim 49 as being unpatentable over Barker in view of Trevino.

XVIII. The 35 U.S.C. § 103(a) rejection of claim 51 as being unpatentable over Barker in view of Mercier

As the examiner's application of Mercier does not cure the above noted shortcomings of Barker relative to parent claim 17, we shall not sustain the 35 U.S.C. § 103(a) rejection of dependent claim 51 as being unpatentable over Barker in view of Mercier.

XIX. New ground of rejection

As our analysis of the Barker reference vis-a-vis the subject matter on appeal differs substantially from that advanced by the examiner, we hereby designate all of the sustained rejections which rely on Barker as new grounds of rejection under 37 CFR § 41.50(b) to allow the appellant a fair opportunity to react thereto.

SUMMARY

In summary:

- a) the decision of the examiner to reject claims 2 through 18, 25, 30 through 67 and 69 is affirmed with respect to claims 2 through 7, 9 through 15, 25, 30 through 32, 34 through 38, 54 through 56, 58, 60 through 66 and 69, and reversed with respect to claims 8, 16 through 18, 33, 39 through 53, 57, 59 and 67; and
- b) all sustained rejections involving the Barker reference are designated as new grounds of rejection under 37 CFR § 41.50(b).

Regarding the affirmed rejections, 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejections of one or more claims, this opinion contains new grounds of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of

rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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AFFIRMED-IN-PART; 37 CFR § 41.50(b)

Charles E. Frankfort

CHARLES E. FRANKFORT)
Administrative Patent Judge)

John P. McQuade

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